

**REMARKS**

Claims 1-23 are pending. Claims 1, 17, and 22 are independent claims. No claims have been amended in the present paper.

In the Office Action, claims 1-23 are rejected under 35 U.S.C. § 101 for allegedly failing to recite statutory subject matter. Claims 12, 17, and 22 are rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,067,525 (“Johnson”) in view of U.S. Patent No. 6,236,990 (“Geller”).<sup>1</sup> For the reasons stated below, Applicants respectfully traverse each and every of the foregoing rejections.

**I. SECTION 101 REJECTION OF CLAIMS 1-23**

The Examiner’s basis for rejecting claims 1-23 under 35 U.S.C. § 101 is that Applicants’ claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed. Claims 1, 17, and 21 use the term “database”. However, in the context of [Applicants’] claims a database can be a notebook, or even a piece of paper. Hence, the claimed invention does not promote the progress of science and the useful arts. (Office Action, page 2.)

Applicants respectfully point out that, the provision of the United States Constitution from which the Examiner appears to quote notwithstanding, Section 101 does not require that a claimed invention “promote the progress of science and the useful arts.” Nor does Section 101 require that a “claimed invention . . . fall within the technological arts.” Accordingly, the Section 101 rejection of claims 1-23 should be withdrawn for the sole reason that the bases for the rejection are simply not supported by the plain language of Section 101. Further, Applicants’ claims recite systems and methods that produce useful, concrete, and tangible results, and therefore are

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<sup>1</sup> Paragraph 7 of the Office Action does not initially identify Geller as a basis for the Section 103 rejection of claims 1-23. However, inasmuch as the Examiner acknowledges certain deficiencies of Johnson in the body of the rejection and allegedly cures these deficiencies with Geller (see Office Action, page 5), it is clear that claims 1-23 in fact stand rejected as unpatentable over Johnson in view of Geller.

clearly patentable under Section 101. *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.2d 1368, 1375 (Fed. Cir. 1998). Accordingly, Applicants respectfully request that the Examiner withdraw the Section 101 rejection of claims 1-23.

## **II. SECTION 112 REJECTION OF CLAIMS 12, 17, AND 22**

Claims 12, 17, and 22 each recite “a manual check and confirmation of said hierarchy of options.” The Office Action (page 3) states that this limitation fails to meet the requirement of 35 U.S.C. § 112, second paragraph, to recite “claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The Examiner contends that the recitation of a “manual check” is a recitation of “limitations that occur outside the system.” However, the recited manual check is clearly disclosed in paragraph 122 of Applicants’ Specification, which explains that in one embodiment “the proposed options [in a hierarchy of options] are manually reviewed.” Applicants’ Specification thus makes clear that they regarded the limitation of “a manual check and confirmation of said hierarchy of options” as being included in the subject matter that they regarded as their invention. Accordingly, Applicants respectfully request that the Examiner withdraw the Section 112 rejection of claims 12, 17, and 22.

## **III. SECTION 103 REJECTION OF CLAIMS 1-23**

Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Johnson in view of Geller. However, for at least the independent reasons stated below, the Section 103 rejection of claims 1-23 should be withdrawn.

### **A. Johnson Does Not Teach Or Suggest The Pre-Defined Conditions Required By Claims 1, 17, and 21.**

Claims 1 and 17 each recite “a set of pre-defined conditions related to a recommendation of asset disposition based on an automated analysis of said information [associated with a

plurality of assets] within said system”. Similarly, claim 21 recites “analyzing said information [associated with a plurality of assets] in accordance with a set of pre-defined conditions.” Contrary to the Examiner’s assertion (Office Action, page 3), Johnson nowhere teaches or suggests these claim limitations.

Johnson is directed toward a sales force automation system. (Johnson, Abstract.) Accordingly, the portions of Johnson cited by the Examiner disclose a series of modules to aid in a product sales process, beginning with a “configuration module” used by a salesperson “to accurately configure and price a product that passes engineering, manufacturing, and customer requirements.” (Johnson, 13: 46-48.) Johnson’s configuration module (as well as the rest of Johnson’s system used after the configuration module) has nothing to do with disposing of assets, but rather is intended to support sales of products that might not have even been manufactured at the time of sale. Therefore, Johnson cannot possibly teach or suggest the recited analysis of information associated with a plurality of assets, those assets being actual physical assets such as assets in a fleet of assets as is clearly required by claims 1, 17, and 21. (See, e.g., Specification, paragraph 54.) Johnson at most teaches analyzing product prices, specifications, features and functions, etc., i.e., descriptions of a type of product, and offers no hint of analyzing information associated with actual assets.

Further, Johnson does not teach or suggest any “pre-defined conditions” at all. Rather, Johnson’s series of modules accept inputs and performs calculations based on those inputs. For example Johnson’s “quotation module” takes into account “unit price, quantity, tradein value, discounts, fees, and taxes” and thereby “facilitates calculation and preparation of a bottom line quotation.” (Johnson, 14: 22-25.) Similarly, to take another example, Johnson’s “finance module” is designed “to assist the salesperson in quickly calculating and presenting finance or lease alternatives to customers based on information collected from other modules.” (Johnson, 15: 17-20.) In sum, Johnson teaches at most performing pre-determined calculations, but nowhere suggests that those calculations depend on any pre-defined conditions, much less pre-determined conditions based on an analysis of information associated with a plurality of assets as

is required by claims 1, 17, and 21. And even if Johnson did disclose pre-determined conditions, Johnson contains absolutely no teaching or suggestion of pre-determined conditions used “to determine if an action needs to be taken with respect to asset disposition.” (See Specification, paragraph 114.)

Claims 1, 17, and 21 are accordingly in condition for allowance for at least the foregoing independent reasons, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom.

**B. Neither Johnson Nor Geller Teaches Or Suggests The Hierarchy Of Disposition Options Required By Claims 1, 17, and 21.**

Claims 1 and 17 recite “a hierarchy of disposition options generated by said system based on said at least one of said conditions.” Similarly, claim 21 recites “recommending asset disposition using a hierarchy of disposition options.” Johnson, as the Examiner acknowledges, does “not provide a hierarchy of options.” (Office Action, page 5.) Further, Geller does not cure the deficiencies of Johnson for at least three reasons. First, the Examiner has failed to meet his burden of stating a *prima facie* case of obviousness for the combination of Johnson and Geller at least because the Examiner has provided no motivation to modify Johnson with the alleged teachings of Geller. Second, Johnson and Geller are incapable of being combined to meet Applicants’ claim limitations. Third, Geller fails to teach or suggest “a hierarchy of disposition options”, and therefore even if Johnson and Geller could be combined, such a combination would not render claims 1, 17, and 21 obvious.

**1. Failure To State A *Prima Facie* Case Of Obviousness**

Section 2142 of the MPEP explains the Examiner’s burden of stating a *prima facie* case of obviousness as follows:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant . . . . To

establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, the Examiner has simply failed to state any motivation at all to combine Johnson and Geller to meet Applicants' claim limitations, much less point to any such motivation in the prior art. Rather, the Examiner has simply made a rejection of the form "Johnson teaches X; Geller teaches Y; therefore it would have been obvious to combine Johnson and Geller." (See Office Action, page 5.) Nor has the Examiner stated, much less shown from the prior art, that a combination of Johnson and Geller would have any reasonable expectation of success.

The Examiner has wholly failed to state a *prima facie* case of obvious with respect to claims 1, 17, and 21. Claims 1, 17, and 21 are accordingly in condition for allowance for at least this independent reason, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom.

## **2. Impossibility of Combining Johnson and Geller**

Not only has the Examiner not shown that there would have been a reasonable expectation of success to one of ordinary skill in the art attempting to combine Johnson and Geller, but in fact Johnson and Geller are incapable of combination. Johnson, as noted above, discloses and claims a sales automation system designed to assist salespersons in selling products. Geller, on the other hand, teaches a system to assist shoppers in selecting products from a catalog. (Geller, Abstract, Fig. 3.) The Examiner provides no explanation of how Johnson's system for assisting product *sellars* could be combined with Geller's system for assisting product *purchasers*. Indeed, because Johnson offers absolutely no teaching or suggestion that his system could or should be adapted for use by shoppers, rather than

salespersons, any modification of Johnson with teachings from Geller would be inoperable. That is, even if Geller did teach presenting a hierarchy of asset disposition options to a potential purchaser, which it does not, a modification of Johnson with Geller's teaching would be pointless, because Johnson's system does not enable use by potential purchasers. Thus, any feature from Geller imported into Johnson simply would not be operable.

Claims 1, 17, and 21 are accordingly in condition for allowance for at least this independent reason, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom.

### **3. Failure Of Geller To Teach "A Hierarchy Of Disposition Options"**

As noted above, claims 1, 17, and 21 each contain clear limitations requiring "a hierarchy of disposition options" for disposing of an asset. The Examiner fails to even contend that Geller anticipates these claim limitations, stating that Geller teaches "a ranking system that allows a user to rank products." (Office Action, page 5.) However, Geller's product ranking is clearly different from the recited "hierarchy of disposition options." Applicants' claims have nothing at all to do with ranking products, and in fact, have nothing to do with ranking assets. Rather, claims 1, 17, and 21 recite "a hierarchy of disposition options" for disposing of an asset, which is in no way taught or suggested by Geller's system for ranking products.

Claims 1, 17, and 21 are accordingly in condition for allowance for at least the foregoing independent reason, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom.

### **C. Applicants' Dependent Claims Are Separately Patentable.**

Although this paper has focused on the patentability of Applicants' independent claims, Applicants wish to stress that their dependent claims present further subject matter that is separately patentable over the prior art of record. For example, nothing in Johnson teaches or suggests "at least one of said conditions being met when an asset approaches the end of a lease term" as is recited in claims 3 and 18. To take another example, nothing in Johnson teaches or suggests "cost variable including a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives" as recited in claims 7 and 18. Accordingly, Applicants

maintain that each of claims 2-16, 18-20, and 22-23 are separately patentable and should be allowed.

## **CONCLUSION**

Claims 1-23 are in condition for allowance. No fees are believed due with this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013, from which the undersigned is authorized to draw, in the name of Rader, Fishman and Grauer PLLC, under order no. 65678-0042.

Respectfully submitted,

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